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Richard J. Knapp

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EXAMINER

NGUYEN, TAN D

ART UNIT

PAPER NUMBER

3689

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/047,717

Applicant(s)

KNAPP, RICHARD J.

Examiner

Tan Dean D. Nguyen

Art Unit

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The amendment of 2/19/08 has been entered.. Claims 1-24 are pending and rejected as followed. Claims 1-14, 22-24 are system claims. Claims 15-21 are method. claims.22-24 are broadest and will be examined first.

### ***Claim Rejections - 35 USC § 112***

2. Claims 1-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1) In claim 22, line 11, the phrase “..by a specifier; and at least...” is vague because it's not clear how this fits in the limitation “said information” earlier.

2) Claim 22 recites the limitation "said information submitted by the specifier" and "said submitted e-palette" in lines 12-13. There is insufficient antecedent basis for this limitation in the claim. There is no teaching with respect to the “submitting” function earlier.

3) Claim 23 recites the limitation "said parameters" on line 4. There is insufficient antecedent basis for this limitation in the claim.

4) Claim 24 recites the limitation "said at least one responsive e-palette submission" on lines 1-2. There is insufficient antecedent basis for this limitation in the claim.

5) In claim 24, the phrase "is accessible only to said specifier" is vague. It appears the access should be to the supplier to be consistent with the scope of the invention as well as other claim set.

6) In claim 15, the last step ( c ) is vague. The permitting of remote access to the e-palette is for the pre-determined set of suppliers at the server and not "by said predetermined set of suppliers at said server."

7) Claim 16 recites the limitation "said parameters" on line 4. There is insufficient antecedent basis for this limitation in the claim.

8) Claim 17, step (a) is vague and the response is to said information of step (a) and not "e-palette" which has been canceled.

9) In claim 1, it's not clear the relationship of "client workstations" in step (a) and "a specifier workstation" in step (b) as well as the relationship of "a specifier workstation" to "a plurality of client workstations" in step (c ). It appears that they both refer to the same element. The "e-palette" information is generated from a or one specifier workstation and it's not clear how the same e-palette in step (c ) now refers it "a plurality of client workstations".

10) Similarly, claim 2 is rejected for the same reason set forth in the rejection of claim 1 (previous rejection) above.

11) Similarly, claim 3 is rejected for the same reason set forth in the rejection of claim 1(previous rejection) above.

12) Claim 5 recites the limitation "said parameters" on line 2. There is insufficient antecedent basis for this limitation in the claim.

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13) Claim 7 recites the limitation "said parameters" on line 1. There is insufficient antecedent basis for this limitation in the claim.

14) Similarly, claims 8-9 are rejected for the same reason set forth in the rejection of claim 1 (previous rejection) above.

15) Claim 8 recites the limitation "said plurality of parameters" on line 3. There is insufficient antecedent basis for this limitation in the claim.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 22-24 (system), 15-21 (method), and 1-14 (system) are rejected under 35 U.S.C. 103(a) as obvious over BADE ET AL in view of YON et al or vice versa.

As of 2/15/08, claim 22 and 15 are as followed:

22. (Currently Amended) A system for facilitating communications between a specifier and ~~one or more~~ a plurality of suppliers, said system comprising:

a) a server in communication with a plurality of client workstations and adapted to receive ~~e-palette~~ information;

b) a processor associated with said server that includes programming for limiting access to and controlling integrity of said ~~e-palette~~ information; and

c) a storage medium associated with said server for receiving and storing said e-palette information, wherein said ~~e-palette~~ information includes specifier information originating from a specifier workstation and including a specified ~~includes an~~ e-palette and information associated with said specified e-palette defined parameters communicated to said server by a specifier; and at least one responsive e-palette submission communicated to said server by a supplier, said information submitted by the specifier ~~parameters including a~~ M a set of goods associated with said submitted e-palette.

15. (Currently Amended) A method for facilitating communications between a specifier and ~~one or more~~ a plurality of suppliers, said method comprising:

a) receiving information ~~an e-palette~~ across a computer network at a server, said information ~~e-palette~~ originating from a specifier workstation and including an e-palette and information associated with e-palette defined by said specifier, said information

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associated with said e-palette including a set of goods and a predetermined set of suppliers ~~associated with said e-palette by said specifier;~~

b) automatically communicating to said predetermined set of suppliers the existence of said e-palette at said server; and

c) permitting remote access to said e-palette by said predetermined set of suppliers at said server.

Claim interpretation:

1) note that step ( c), the phrase "permitting remote access" merely means "giving permission for remote access" and not "remotely accessing the ..."

**As for independent system claim 22**, Similarly, **BADE et al** discloses a method for facilitating communications (or "...collaborative method of designing systems ..." {see par. 0022"}) between plurality of entities, 1<sup>st</sup> entity functions as a specifier and a 2nd plurality of entities function as plurality of suppliers, said method comprising:

a) receiving information from an order across a computer network at a server, the information originating from a 1<sup>st</sup> entity (specifier) workstation and including information about the project/design project, said information associated with the project defined by the 1<sup>st</sup> entity (specifier), the information associated with the project/design including a set of goods (product) and a predetermined set of suppliers;

{see Figs. 2, 41, paragraphs [0009], [0023], [0108], [0111], and [0207]}

b) automatically communicating to said predetermined set of suppliers the existence of said project/project design at said server; and

{see paragraphs [0207]-[0208], Figs. 8 and 44]}

c) permitting remote access to said project/project design by said predetermined set of suppliers at said server.

{see [0023 "...a vendor to access a design published by a designer on the bidding board... vendor may receive a request for quote that includes access privilege to the design..."], [0207]}.

BADE et al fairly teaches the claimed invention except for the features of the information in the order/quote received contains specified color data spectra or e-palette information and information associated with the specified e-palette.

Similarly, **YON et al** discloses a method for facilitating communications between 2 entities, first entity serving as a specifier and a 2nd entity serving as one or more suppliers, said method comprising:

a) receiving an order in the form of electronic (web) template/page or palette across a computer network at a server, said template/page (palette) originating from a specifier (customer or purchaser) workstation and including parameters related to said template/palette, said parameters including a set of goods (product) and a predetermined set of suppliers associated with said template/palette by said specifier (customer/purchaser);

{see Figs. 1, 2, elements 32, 34, 36, 44, Fig. 4, elements 52, Fig. 6, 60, cols. 3, lines 5-65, col. 4, lines 5-40, col. 7, lines 1-65}

b) automatically communicating to said predetermined set of suppliers the existence of said template/web page (palette) at said server; and



{see Fig. 1, col. 3, lines 4-45, col. 7, lines 1-60}}

c) permitting remote access to said template/palette by said predetermined set of suppliers at said server.

{see col. 3, lines 4-40, col. 7, lines 1-12, col. 8, lines 4-45}.

Note, as for the term "e-palette" which appears to be similar to electronic template or page or web page, this is taught in YON et al on cols. 3-4, Figs. 2-5. Note that on col. 4, lines 15-20, YON et al discloses the field (44) on Fig. 2 as "color palette field". Therefore, the teaching of Fig. 2 reads over "e-palette". Alternative, since the palettes of Fig. 2 and col. 4, lines 1-25 are transferred via electronically (via the Internet), it would have been obvious to change the name of web page or template in YON et al to e-palette if desired to indicate that the palette is carried out electronically.

It would have been obvious to modify the order information about the design project of **BADE et al** to include specified color data spectra or e-palette information and information associated with the specified e-palette as taught by YON et al if the design item requires color feature or desired color as taught by YON et al {see cols. 1-2, Figs. 2-6.

Alternatively, YON et al fairly teaches the claimed invention except for a plurality of suppliers in the preamble and the access to the order information. It would have been obvious to modify the teachings by including the two features above as taught by **BADE et al** to allow effective or better bidding when multiple vendors or suppliers are involved and are competed against each other to inherently provide good service at lower cost.

**As for dep. claim 23** (part of 22 above), which deal with well known color spectra data or e-palettes parameters and order parameters, these are well known and are taught in cols. 3-5 or 7 or Figs. 2, 4 and 6 of YON et al. Note also, that these are further limitation or functions on the information/data received in step (c ) and stored in the database, they are considered as non-functional descriptive material (NFDM) and have no patentable weight. Data are data and functions or intended use on the data have no patentable weight unless the function or intended use of the data are carried out.

**As for dep. claim 24** (part of 22 above), which deal with well known data management, i.e. accessible by a party such as the specifier, this is taught in BADE et al [0023] or [0207]. Moreover, the information/data on database "accessing" feature or parameter by any party such as specifier or supplier, is also taught by YON et al on col. 6, line 65 to col. 7, line 10.

**As for independent method claim 15**, which is basically the method to carry out the system claim 22 above, it's rejected over the steps of BADE et al /YON et al or vice versa to carry out the elements as shown in the rejection of claim 22 above.

**As for dep. claim 16** (part of 15 above), which has the same limitation as in dep. claim 23 (part of 22 above), it's rejected for the same reason set forth in the rejection of dep. claim 23 above.

**As for dep. claims 17-19** (part of 15 above), which deal with well known effective communication parameters between entities to facilitate the transaction (order)

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effectively or properly, these are well known and are taught in Figs. 1, 2 and 4, "Search", "Browse", "Options" and "Order" and "Verification", and cols. 3-8, especially col. 5, lines 15-20, 45-67. Alternatively, it would have been obvious to a skilled artisan to provide iterative communication between the two entities, reports with respect to the communication above to ensure effective or clear communication between the two entities with respect to the order (transaction) so errors due to misunderstanding or lack of reporting can be avoided.

**As for dep. claim 20** (part of 15 above), which has the same limitation as in dep. claim 24 (part of 22 above), it's rejected for the same reason set forth in the rejection of dep. claim 24 above.

**As for dep. claim 21** (part of 15 above), which deal with well known practice for checking or validating operation of a color measuring (matching) equipment related in the transaction to ensure proper color communication between two entities, this is taught in col. 4, lines 26-65, col. 7, lines 15-67, Fig. 6.

Note on col. 8, lines 33-40, "understood by those skilled in the art that various changes may be made and equivalents maybe substituted for elements thereof without departing from the scope of the invention.... Many modifications....", these limitations as shown in the above dependent claims are well known non-essential inputs, changes and/or modifications to provide effective e-communication parameters of various parties involved in an e-transaction related to color features and would have been obvious to a skilled artisan to carry out these parameters.

**As for system claims 1-14**, which are merely system to carry out the method claims 15-21 respectively above, they are rejected over the system of BADE et al and YON et al or vice versa to carry out the rejection of method steps claims 15-21 as cited above. Alternatively, the set up of a computer system to carry out the computer-implemented method claim 15 above would have been obvious to a skilled artisan.

Note also, that the essential function in dependent claims. 3-4, 6-7, 9-14, uses the "step languages", i.e. "communicates", "is selected from", "utilizes", "provides" or "operates", "is in communication", in an apparatus claim, and these steps/limitations have no patentable weight in an apparatus claims. See MPEP 2114-2115. "...claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function or interaction between elements. *In re Schreiber*, 128, 44 USPQ2d 1429, 1431-1432 (Fed. Cir. 1997).

6. Dependent claim 21 is rejected (2<sup>nd</sup> time) under 35 U.S.C. 103(a) as being unpatentable over BADE ET AL /YON et al as applied to claims 1-21 above, and further in view of CHAN.

CHAN is cited to teach the inclusion of a color measuring equipment (spectrophotometer) to measure the color attributes associated with an electronic color spectra received on a computer {see Fig. 1, 2, 14, col. 4, lines 45-59}. It would have been obvious to modify the teachings of BADE ET AL/YON et al to include a color measuring equipment (spectrophotometer) for inputting accurate color parameters or appropriate coordinates of a color space on a computer as taught by CHAN. The

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validation of a proper operation of the color measuring equipment (spectrophotometer) would have been obvious to a skilled artisan to ensure accurate color measurement and matching as required in CHAN.

### ***Response to Arguments***

7. Applicant's arguments on 2/19/08 with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection which are caused by applicant's amendment of the claims.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) NPL: The Article of "Pantone Announces ...for E-commerce", 11/30/1999 fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

2) NPL: The article "color World", April-Sept. 1999, fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

3 ) NPL: The article "TextileMaster", by X-Rite, April 2000, fairly teaches the claimed invention above and cited here for applicant's awareness of potential use in the future if needed to avoid multiple rejections.

No claims are allowed.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct@uspto.gov>. Should you have any questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll free).

In receiving an Office Action, it becomes apparent that certain documents are missing, e. g. copies of references, Forms PTO 1449, PTO-892, etc., requests for copies should be directed to Tech Center 3600 Customer Service at (571) 272-3600, or e-mail [CustomerService3600@uspto.gov](mailto:CustomerService3600@uspto.gov).

Any inquiry concerning the merits of the examination of the application should be directed to Dean Tan Nguyen at telephone number (571) 272-6806. My work schedule is normally Monday through Friday from 6:30 am - 4:00 pm. I am scheduled to be off every other Friday.

Should I be unavailable during my normal working hours, my supervisor Janice Mooneyham can be reached at (571) 272-6805.

The main FAX phone numbers for formal communications concerning this application are (571) 273-8300. My personal Fax is (571) 273-6806. Informal communications may be made, following a telephone call to the examiner, by an informal FAX number to be given.

/Tan Dean D. Nguyen/  
Primary Examiner, Art Unit 3689